

6

REMARKS

This amendment is filed in response to the Office Action dated March 20, 2002. Claims 1-7, 10-14 and 18-32 are pending prior to this amendment. In the Office Action of March 20, 2002, the Examiner rejected claims 1-5, 7, 18-21, 23, 25-29 under 35 U.S.C. § 102(e) as being anticipated by Liao et al., U.S. Patent No. 6,292,833 ("Liao"); rejected claims 6, 10-12, 14, 22 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Liao in view of Zicker et al., U.S. Patent 5,862,475 ("Zicker"); rejected claims 13, and 30-31 under 35 U.S.C. § 103(a) as being unpatentable over Liao; and rejected claim 32 under 35 U.S.C. § 103(a) over Liao in view of Galvin, U.S. Patent No. 6,134,315.

By this amendment, claims 1, 3, 4, 6-7, 10-14, and 25-32 are amended to more particularly and distinctly claim the invention. In particular, the independent claims 1, 4, and 25 are amended to clearly indicate that a person, for example, a called or calling party, is alerted to security status of a transmission link. The dependent claims are amended to conform to the amendment of the independent claims. Support for the amendment of the claims is found throughout the specification and drawings, and in particular, in the specification, at page 1, line 28 through page 2, line 17. Claim 2 is cancelled. The Examiner's rejections are traversed below in light of the amended claims.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached document is captioned "Version With Markings To Show Changes Made."

Claims 1-5, 7, 18-21, 23, 25-29 Are Not Anticipated by Liao

The Examiner rejected claims 1-5, 7, 18-21, 23, 25-29 under 35 U.S.C. 102(e) as being anticipated by Liao. Claim 2 is cancelled.

making the rejections made with respect to that claim moot. The Applicant respectfully traverses the rejection with respect to claims 1, 3-5, 7, 18-21, 23, 25-29 on the basis that these claims include certain novel limitations that are not disclosed by Liao. In particular, as discussed further below, Liao fails to disclose a means or method for a person, e.g., a called party, calling party, or user of a customer premise equipment, to be alerted to the security status of a communications link or transmission. Though Liao relates the security status of a link to a communications device, the security status is not made available to a user of the device so that the user can make decisions based on the security status.

The Federal Circuit has stated, in reference to anticipation, that "[t]here must be no difference between the claimed invention and the reference disclosure, as viewed by one of ordinary skill in the field of the invention." *Scripps Clinic & Research Found. v. Genetech Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

According to the Examiner, with reference to claim 1, Liao discloses all the elements of the claim. However, amended claim 1 includes novel elements not disclosed by Liao. In particular, amended claim 1 includes:

- a customer premise equipment coupled to a terminating network node;
- an originating network node connected to the terminating network node via at least one other network node; and
- said at least one other network node equipped with a processor for transmitting a message to the customer premise equipment via the terminating network node, the message indicating to a user of the customer premise equipment that a transmission was received over a non-private link subject to unauthorized interception.

Liao discloses a security status of a transmission link being reported to a mobile communications device. The mobile

communications device then uses that status to make decisions regarding transmissions received over that link. However, Liao does not disclose that the security status is made available to a user of the communications device. This is significant, at least in that, in Liao, a user cannot make decisions in light of the security status. The Examiner cites to Liao, column 3, lines 4-11 for the proposition that Liao provides an alert including a message on an identification display. (See rejection of claim 7.) However, the cited text only indicates that the mobile device has a display for graphics and text. There is no indication that the security status is displayed to a user. In contrast to the prior art, the present invention advantageously permits a user to receive the security status of a communications link and make further decisions, such as whether to continue a transmission, in light of the security status. Hence, claim 1 is not anticipated by Liao.

In addition, Liao does not make claim 1 obvious. Liao is principally concerned with access to local services of mobile devices. In Liao, there is some consideration of the security status of communications made to change local service. However, Liao does not recognize the problem or solution of concern in the present invention, namely, allowing a user to prevent insecure communications when secure communications are desired. Therefore, Liao lacks the necessary teaching to even suggest to one of skill in the art the solution provided by the present invention.

The method of independent claim 4 includes:

- establishing a route from an originating network node to a terminating network node;
- determining whether at least a portion of the route includes an insecure link; and
- responsive to the step of determining whether at least a portion the route includes an insecure link and prior to connection to said terminating network node, providing an alert of a security status of the route to a calling party using the originating network node.

Similarly, independent claim 8 includes:

means for interconnecting a caller to a called party;
and

means for alerting the caller or called party when a
call path is established using at least one insecure link.

And, independent method claim 25 includes, among other things, the steps of:

a. establishing a route from a calling party to a called party;
b. determining whether at least a portion of the route includes a non-private link subject to unauthorized interception;

...

d. responsive to a positive result in said determining step and a negative result in said further determining step, providing an alert of the insecure nature of the route to said calling party.

Each of independent claims 4, 18, and 25 requires an alert of a security status of a route, call path, or link to a person, that is, a caller, calling party, or called party. As discussed above, with respect to claim 1, Liao does not disclose, suggest or teach, at least this novel element of the present invention. Hence, independent claims 4, 18, and 25 are novel. In addition, as discussed above with respect to claim 1, Liao does not make the claims obvious, due in part, to its lack of teaching on the problem and solution of the present invention. The dependent claims 3, 5-14, 19-24 and 26-32 depend ultimately from one of the independent claims, and are patentable for at least the reasons given above for the independent claims.

The Claims Are Patentable Over Liao And Zicker

The Examiner rejected claims 6, 10-12, 14, 22 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Liao in view of Zicker.

According to the Examiner, Liao teaches all the elements of the subject claims, except Liao fails to teach an alert in the system including a distinctive ringing at the recipient's station, an audible voice message, an audible tone, providing a periodic alert, a query screen on a personal computer, warning signals throughout the call and special parameters for a particular subscriber. According to the Examiner, Zicker teaches the alerts that are missing in Liao. The Examiner concludes that the claims are obvious in view of the combination of Zicker and Liao.

The Applicants disagree with the Examiner's conclusion. First, even assuming a combination of Zicker and Liao is appropriate, such a combination still fails to disclose certain novel elements of the subject claims. Namely, a combination of Zicker and Liao fails to disclose providing an alert relating to a security status of a transmission or link to a calling party, caller, calling party or user of a customer premise equipment, as discussed above. In addition, neither Zicker nor Liao actually recognizes or addresses the problem solved by the present invention. Zicker discloses a wireless communication system with handsets that automatically switch between a cellular mode of operation and a cordless mode of operation. Liao generally discloses techniques for insuring secure access to local service options of mobile communication devices. Neither of the references is directed to alerting a user of the security status of a communications link. Hence, there is no motivation for one of ordinary skill in the art to combine the references to address the problems solved by the present invention.

The Claims Are Not Obvious In View Of Liao

The Examiner rejected claims 13 and 30-31 under 35 U.S.C. § 103(a) as being unpatentable over Liao. According to the Examiner Liao teaches all the elements of the subject claims, except Liao fails to

11

teach that the system issues an alert when a previously secure route becomes insecure. The Examiner goes on to suggest that it is obvious that when a network site is insecure, the network site will be denied by the system and an alert message will be issued. This assertion is apparently not supported by a reference. The Examiner concludes that Liao plus the Examiner's suggestion makes the claims obvious.

The Applicants disagree with the Examiner's conclusion of obviousness. The Examiner's suggestion that "it is obvious that when the network site is insecure, then the network site will be denied by the system and an alert message will be issued" is not supported by a reference and the prior and current art generally. Indeed, the majority of network access in the current art made over the Internet is made without regard to the security of the network. The Examiner's suggestion appears to be motivated by impermissible hindsight, in light of the present invention itself. Moreover, as discussed above, Liao fails to disclose certain novel features that are included in claims 13 and 30-31. Namely, providing an alert relating to a security status of a transmission or link to a calling party, caller, calling party or user of a customer premise equipment. Therefore, claims 13 and 30-31 are not obvious and are patentable.

The Claims Are Not Obvious In View Of Liao And Galvin

The Examiner rejected claim 32 under 35 U.S.C. § 103(a) as being unpatentable over Liao in view of Galvin. According to the Examiner, Liao teaches all the elements of the subject claims except that Liao fails to teach establishing a new route between said sender and said recipient. The Examiner indicates that Galvin teaches routing such that it would have been obvious to one of skill in the art to combine Galvin and Liao to provide the alternative route as claimed.

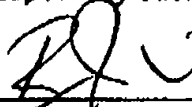
12

The Applicants disagree with the Examiner's conclusion of obviousness. First, even assuming a combination of Galvin and Liao is appropriate, such a combination still fails to disclose certain novel elements of the subject claims. Namely, a combination of Galvin and Liao fails to disclose providing an alert relating to a security status of a transmission or link to a calling party, caller, called party or user of a customer premise equipment, as discussed above. In addition, neither Galvin nor Liao actually recognizes or addresses the problem solved by the present invention. Neither of the references is directed to alerting a user of the security status of a communications link. Hence, there is no motivation for one of ordinary skill in the art to combine the references to address the problems solved by the present invention.

CONCLUSION

All pending claims are in condition for allowance. Allowance at an early date is solicited.

Respectfully submitted,



Reginald J. Hill
Registration No. 39,225
Attorney for Applicants

Date: May 20, 2002

R.J. HILL & ASSOCIATES, LTD.
19 South LaSalle Street
Suite 1402
Chicago, IL 60603
(312) 236-3672
amendment a 50001-10070

Version With Markings To Show Changes Made

In the Claims:

Claim 1 is amended as follows:

1. (Twice amended) A telecommunications network comprising:
a customer premise equipment coupled to a terminating network
node;

an originating network node system connected to a the
terminating network node system via at least one other network
element node; and

a said at least one other network element node equipped with a
processor for transmitting a message to the customer premise
equipment via the terminating system network node, the message
indicating to a user of the customer premise equipment that a
transmission was received over a non-private link subject to
unauthorized interception.

Claim 3 is amended as follows:

3. (Twice amended) A The telecommunications network of
claim 1 further comprising wherein the originating system network node
alerting alerts a calling party using a customer premise equipment
coupled to the originating network node of presence of said non-private
link.

Claim 4 is amended as follows:

4. (Twice amended) A method for providing secure
transmissions in a telecommunications network comprising the steps
of:

establishing a route from an originating network node sender to
a recipient terminating network node;

14

determining whether at least a portion of the route includes an insecure link; and

~~responsive to determination that the step of determining whether at least a portion~~ the route includes an insecure link ~~and prior to connection to said terminating network node~~, providing an alert of a security status of the route to a calling party using the originating network node ~~said sender and prior to connection to said recipient an alert of the insecure nature of the transmission.~~

Claim 6 is amended as follows:

6. (Twice amended) The method of claim 4 wherein providing ~~an the~~ alert includes issuing a distinctive ring at a station associated with the recipient ~~terminating network node~~.

Claim 7 is amended as follows:

7. (Amended) The method of claim 4 wherein providing ~~an the~~ alert includes issuing a message on an identification display associated with one of a station associated with the terminating network node and the calling party.

Claim 10 is amended as follows:

10. (Amended) The method of claim 4 wherein providing ~~an the~~ alert includes providing an audible voice message.

Claim 11 is amended as follows:

11. (Amended) The method of claim 4 wherein providing ~~an the~~ alert includes using an audible tone.

Claim 12 is amended as follows:

12. (Amended) The method of claims 10 or 11 wherein

15

providing ~~an~~the alert includes providing a periodic alert.

Claim 13 is amended as follows:

13. (Amended) The method of claim 4 further comprising:
issuing ~~an~~the alert when a previously secure route becomes insecure.

Claim 14 is amended as follows:

14. (Amended) The method of claim 4 wherein providing ~~an~~the alert includes a query screen on a personal computer.

Claim 25 is amended as follows:

25. (Amended) A method for providing secure transmissions in a telecommunications network comprising the steps of:

- a. establishing a route from a ~~sender~~calling party to a ~~recipient~~called party;
- b. determining whether at least a portion of the route includes a non-private link subject to unauthorized interception;
- c. responsive to a positive result in said determining step, further determining whether a secure connection may be established between said ~~sender~~calling party and said ~~recipient~~called party; and
- d. responsive to a positive result in said determining step and a negative result in said further determining step, providing an alert of the insecure nature of the route to said calling party.

Claim 26 is amended as follows:

26. (Amended) The method of claim 25 wherein said telecommunications network includes at least one intermediate node in said route from said ~~sender~~calling party to said ~~recipient~~called party, and wherein step c. thereof further comprises the step of:

16

transmitting a message including a security status request through each of said at least one intermediate node.

Claim 27 is amended as follows:

27. (Amended) The method of claim 25 wherein said telecommunications network includes at least one intermediate node in said route from said sender-calling party to said recipient-called party, and wherein step c. thereof further comprises the step of:

for each of said at least one intermediate node, if such node is insecure, receiving a message indicating such node is insecure.

Claim 28 is amended as follows:

28. (Amended) The method of claim 25 further comprising the step of:

e. establishing a secure connection between said sender-calling party and said recipient-called party.

Claim 29 is amended as follows:

29. (Amended) The method of claim 25 further comprising the step of:

e. establishing a connection between said sender-calling party and said recipient-called party despite a determination that a secure connection cannot be established.

Claim 30 is amended as follows:

30. (Amended) The method of claim 25 wherein said alert is provided to a user of said sender-calling party, and the method further comprises the steps of:

e. receiving authorization from said user-calling party, after said user-calling party has received said alert, to maintain a connection

17

between said ~~sender~~calling party and said ~~recipient~~called party.

Claim 31 is amended as follows:

31. (Amended) The method of claim 25 wherein said alert is provided to a ~~user of~~ said ~~sender~~calling party, and further comprises the steps of:

e. receiving authorization from said ~~user~~calling party, after said ~~user~~calling party has received said alert, to establish a connection between said ~~sender~~calling party and said ~~recipient~~called party.

Claim 32 is amended as follows:

32. (Amended) The method of claim 25 further comprising the step of:

e. responsive to a positive result in said determining step and a negative result in said further determining step, establishing a new route between said ~~sender~~calling party and said ~~recipient~~called party.

Claim 2 is cancelled.